

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL R. POTTER and BRUCE J. KILGORE

Appeal No. 95-3510
Application No. 08/032,405¹

HEARD: August 5, 1997

Before MCCANDLISH, Senior Administrative Patent Judge, and
LYDDANE and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 29, 31 through 45 and 47 through 51, which are all of the claims pending in this application.

¹ Application for patent filed March 12, 1993. According to the appellants, the application is a continuation of Application No. 07/879,725, filed May 6, 1992, which was a continuation of Application No. 07/702,129, filed May 16, 1991, which was a continuation of Application No. 07/480,586, filed February 15, 1990, which was a continuation-in-part of Application No. 07/324,705, filed March 17, 1989, and a continuation-in-part of Application No. 07/416,262, filed October 3, 1989.

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We REVERSE.

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BACKGROUND

The appellants' invention relates to an athletic shoe with a pressurized ankle collar for use in activities where plantar and dorsi flexion of the foot occurs about the medial and lateral malleoli of the foot.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Keen	746,338	Dec. 8, 1903
Broecker et al. (Broecker)	2,103,108	Dec. 21, 1937
McCoy	2,276,502	Mar. 17, 1942
Gilbert	2,600,239	June 10, 1952
Bullard III	2,638,690	May 19, 1953
Nishimura	3,758,964	Sep. 18, 1973
Thedford	4,123,855	Nov. 7, 1978
Huang	4,670,995	June 9, 1987
Pagani	4,739,813	Apr. 26, 1988

Claims 1 through 8, 11, 29, 31 through 37, 39 through 42, 45 and 47 through 51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Gilbert and Thedford.

Claims 9, 10, 37, 38, 43 and 44 stand rejected under

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35 U.S.C. § 103 as being unpatentable over Nishimura in view of Gilbert and Thedford as applied to claims 8, 36 and 42 above, and further in view of Keen.

Claims 12, 13 and 18 through 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Gilbert and Thedford as applied to claim 1 above, and further in view of Bullard III.

Claims 14 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Gilbert, Thedford and Bullard III as applied to claim 12 above, and further in view of Pagani.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Gilbert, Thedford and Bullard III as applied to claim 12 above, and further in view of McCoy and Broecker.

Claim 28 stands rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Gilbert and Thedford as applied to claim 1 above, and further in view of Huang.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejections, we make reference to the examiner's answer (Paper No. 37, mailed February 21, 1995) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 36, filed December 30, 1994) and reply brief (Paper No. 39, filed April 21, 1995) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claims 1 through 29, 31 through 45 and 47 through 51. Accordingly, we will not sustain the examiner's rejections of claims 1 through 29, 31 through 45 and 47 through 51 under 35 U.S.C. § 103. Our reasoning for this determination follows.

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In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This the examiner has not done.

With regard to the 35 U.S.C. § 103 rejection of independent claims 1, 31 and 47 as being unpatentable over Nishimura in view of Gilbert and Thedford, the examiner concluded that

[i]t would have been obvious to provide the athletic shoe as taught above with the bladder comprising an [sic] horizontal

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divider in the area of the medial and lateral malleoli or in any other desired location, in view of the teachings of Gilbert and Thedford, to provide supporting pressure at desired locations (answer, p. 4).

We do not agree.

We agree with the appellants' argument (brief, p. 17) that one of ordinary skill in the art would have found no reason in the references themselves for incorporating the insole weld lines of Gilbert and Thedford into the ankle bladder taught by Nishimura. Thus, the combined teachings of Nishimura, Gilbert and Thedford would not have suggested

(1) "prevention means incorporated into both said medial and lateral sections of said bladder for preventing the formation of restrictive vertical columns of pressurized gas in said medial and lateral sections when pressurized gas is supplied to the interior of said bladder, whereby the inflated bladder does not substantially inhibit planter and dorsi flexion of a foot in the ankle portion of the upper of said athletic shoe, said prevention means including connection points between said two layers of elastomeric material defining small areas of fluid communication between areas of the bladder, with the small defined areas being insufficient in size to allow the formation of restrictive vertical columns" as set forth in claim 1,

(2) "a divider extending generally horizontally in each of said medial and lateral sections for dividing said sections into the respective upper and lower chambers, said dividers defining small areas of fluid communication between said upper and lower chambers that are insufficient in size to allow the formation of restrictive vertical columns of pressurized gas in the medial and lateral sections, whereby the inflated bladder does not substantially inhibit plantar and dorsi flexion of a foot in the ankle portion of the upper of said athletic shoe" as set forth in claim 31, or

(3) "connection points between said two layers of elastomeric material defining small areas of fluid communication between areas of the chambers, said defined small areas being insufficient in size to allow the formation of restrictive columns of pressured fluid adjacent the malleoli that would substantially restrict plantar and dorsi flexion of the foot within said athletic shoe when said chambers are pressurized with fluid" as set forth in claim 47.

As stated in W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

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[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied prior art references in the manner proposed by the examiner results from a review of the appellants' disclosure and the application of impermissible hindsight.

For the reasons set forth above, we cannot sustain the examiner's rejections of independent claims 1, 31 and 47, or of claims 2 through 29, 32 through 45 and 48 through 51 dependent thereon², under 35 U.S.C. § 103.

² We have also reviewed the Keen, Broecker, McCoy, Huang, Bullard III and Pagani references additionally applied in the rejections of dependent claims 9, 10, 12 through 28, 37, 38, 43 and 44 but find nothing therein which makes up for the deficiencies discussed above regarding claims 1, 31 and 47.

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CONCLUSION

To summarize, the decision of the examiner to reject claims
1 through 29, 31 through 45 and 47 through 51 under 35 U.S.C.
§ 103 is reversed.

REVERSED

HARRISON E. MCCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
WILLIAM E. LYDDANE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/032,405

APJ NASE

SAPJ MCCANDLISH

APJ LYDDANE

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 07 Aug 97

FINAL TYPED: